

REMARKS

By this amendment, applicants have amended the claims to more clearly define their invention. In particular, claim 1 has been amended to recite that the lacquer paint comprises, in addition to the polymer-based lacquer and the conductive additives, a non-conductive filler or pigment. See, e.g., page 3, lines 8-20 in the specification and original claim 4. Claims 6, 9, 10, and 17 have been amended to be consistent with amended claim 1 and claims 4 and 16 are canceled without prejudice or disclaimer.

Claims 1, 3 to 12, and 15 to 19 stand rejected under 35 U.S.C. 112, first paragraph. In support of this rejection, it has been urged by the Examiner that he "fails to find any direct support for the claimed terminology '...the conductive additives is not having a modifying agent coating thereon.'" Applicants traverse this rejection and request reconsideration thereof.

As the Examiner correctly notes, any negative limitation or exclusionary proviso must have a basis in the original disclosure. Manual of Patent Examining Procedure (MPEP) 2173.05(i). It is submitted, however, the negative limitation presently recited, i.e., that the conductive additive does not have a further modifying agent coating thereon, would have been conveyed to one having ordinary skill in the art by the originally filed disclosure, contrary to the allegations made by the Examiner.

As recognized by the Board of Patent and Appeals and Interferences:

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention on any ground is always upon the examiner. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, it is incumbent upon the examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that an appellant had possession of the now claimed subject matter. Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26

USPQ2d 1767 (Fed. Cir. 1993). Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention. In re Herschler, 591 F.2d 693, 200 USPQ [\*5] 711 (CCPA 1979); In re Edwards, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

The examiner contends that the rejected claims lack adequate descriptive support because there is "no literal basis for the" n2 claim limitation "in the absence of a catalyst." Clearly, the observation of a lack of literal support does not, in and of itself, establish a prima facie case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112. In re Herschler, supra; In re Edwards, supra; In re Wertheim, supra.

Ex parte Parks, 30 U.S.P.Q. 2<sup>nd</sup> 1234, 1236 (Bd. of Pat. App. and Inter. 1993).

As in Parks, the Examiner here contends that the rejected claims lack adequate descriptive support because there is no "direct support for the claimed terminology." Clearly, the lack of direct or literal support does not per se establish a prima facie case for lack of adequate descriptive support under 35 U.S.C. 112, first paragraph. To the contrary, it is submitted the originally filed disclosure would have conveyed to one having ordinary skill in the art that Applicants had possession of the concept that is claimed. The specification clearly describes the types of conductive additives and provides numerous examples thereof. While these conductive additives can be conductively coated materials, clearly none of these additives have any further modifying agent coating thereon.

Based on the description and examples in Applicants' specification, the originally filed disclosure would have conveyed to one having ordinary skill in the art that Applicants had possession of the concept which is now claimed. Accordingly, reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 112, first paragraph, are requested.

Claims 1, 3-12, and 15-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being obvious over either U.S. Patent 5,320,781 to Stahlecker et al. or U.S. Patent No. 5,350,448 to Dietz et al. Applicants traverse this rejection and request reconsideration thereof.

The present invention is directed to a lacquer provided with anti-static properties. The lacquer paint includes a polymer-based lacquer, non-conductive filler or pigment and the conductive additive set forth in claim 1. As the result of the conductive additives, a network of electrically conductive paths are formed in the lacquer paint matrix, by way of which electric charges can flow away in a targeted manner, i.e., by the percolation theory. By combining the conductive additives with non-conductive fillers and/or pigments, the "extender effect" is exploited without losses resulting in the conductivity in the compound system. The "extender effect" makes it possible to reduce the amount of conductive additives that is necessary. See, e.g., page 3, lines 8-20 of Applicants' specification.

The patents to Stahlecker et al. and Dietz et al. disclose various specific electrically conductive pigments. In Stahlecker et al., the conductive pigment contains 20 to 90% by weight of a component A comprising one or more conductive platelet-like pigments and 5 to 80% by weight of a component B comprising one or more conductive needle-shaped or fibrous pigments. In Dietz et al., the pigments consist of one or more metals, metal oxides, or materials containing metal oxide, silicon oxide or silicate materials and contain, if desired, one or more other metal oxide and/or silicon dioxide layers, and a layer based on halogenate-doped tin oxide and/or titanium oxide.

While both patents disclose the use of the pigments in lacquer systems, it does not appear that these patents disclose the combination of such pigments in

lacquer systems with non-conductive filler and/or pigment. Accordingly, the presently claimed invention is patentable over Stahlecker et al. and Dietz et al.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance of all of the claims now in the application are requested.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 306.38504X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

  
Alan E. Schiavelli  
Registration No. 32,087

AES/at  
(703) 312-6600  
Attachments